

Appl. No. 09/469,982
Amdt. Dated October 13, 2004
Reply to final Office action of July 13, 2004

REMARKS/ARGUMENTS

This Amendment is in response to the final Office Action mailed July 13, 2004. In the final Office Action, the Examiner rejected claims 1, 4-5, 8-9, 11, 14-15, and 18 under 35 U.S.C. §103. Claims 1, 4, 5, 9, 11, 14, and 15 have been amended. New claims 19-22 have been added. Applicants submit that the newly added claims introduce no new matter. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Applicant has filed a Request for Continued Examination (RCE) and has amended the claims to further clarify embodiments of the invention. In view of these clarifications, Applicant respectfully submits that the claims are clearly patentable.

Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 1, 4-5, 8-9, 11, 14-15, and 18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,233,613 issued to Walker et al. ("Walker") in view of U.S. Patent No. 5,898,837 issued to Guttman et al. ("Guttman"). Applicants respectfully traverse the rejections and contend that a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143, p. 2100-129 (8th Ed., Rev. 2, May 2004)*. Applicants respectfully contend that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established. Before setting forth the reasons for traversing the outstanding §103(a) rejection, a brief review of the cited references may be appropriate.

Walker discloses high impedance probe for monitoring fast Ethernet LAN links. An external three way connector tapping onto communication lines, in parallel, to bring these lines

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to a probe (Walker, col. 5, lines 8-10). The probe does not use repeater because it is not coupled between the two nodes (Walker, col. 5, lines 28-30).

Guttman discloses a method and apparatus for monitoring a dedicated communications medium in a switched data network. An internal bypass circuitry is used to allow data packets passing through (Guttman, col. 4, lines 66-67; col. 5, lines 1-4).

Walker and Guttman, taken alone or in combination, do not disclose, suggest, or render obvious: (1) controlling a plurality of switches between physical layer interfaces and repeaters using a finite state machine to establish a third communication path to provide a negotiated common mode of operation between the first node and the second node, or (2) a plurality of switches connecting the physical layer interfaces and the repeaters, and (3) a finite state machine to control the plurality of switches.

Walker explicitly discloses that the probe does not use repeaters (Walker, col. 5, lines 28-30). When discussing prior art, Walker merely discloses that the probe must act as a repeater in repeating messages (Walker, col. 2, lines 31-36). None of the prior arts cited by Walker discloses controlling a plurality of switches. Guttman merely discloses relays being used to allow data packets passing through (Guttman, col. 4, lines 61-64). Furthermore, neither Walker nor Guttman discloses a finite state machine to control the switches.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 4-5, 8-9, 11, 14-15, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Guttman.

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Conclusion

In view of the remarks made above, it is respectfully submitted that pending claims 1, 4-5, 8-9, 11, 14-15, and 18 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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Dated: October 13, 2004

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Tu Nguyen

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